

REMARKS

In the Official Action, the Examiner commented on a previously filed Information Disclosure Statement, formally presented the restriction requirement that was originally made by telephone, raised certain rejections under 35 U.S.C. §112 and rejected a few of the elected claims (i.e., claim 4 (which should be claim 3) and claims 11 and 14) as allegedly being anticipated by Cheng et al., U.S. Patent No. 5,516,620.

In response to various points raised in the Official Action, applicants note that only an abstract of JP 09-127683 was cited in the European Search Report that was included in the Information Disclosure Statement filed on November 24, 2003, so that the identification of the abstract in the literature section of the citation form is acceptable. However, to avoid any confusion, a copy of JP 09-127683 has been obtained and has been submitted in an Information Disclosure Statement filed on July 13, 2004. Applicants respectfully request the return of citation form with the document acknowledged in the next Official Action.

With respect to the restriction requirement, applicants confirm the election of the subject matter of Group II which contains claims 3, 10, 11, 14 and 19. This election is made with traverse with respect to claim 17. While the Examiner is correct in understanding that the claim relates to the developed printing plate, given the fact that claim 17 is directly dependent on claim 3, if claim 3 is ultimately found to be allowable, which applicants anticipate in view of the discussion provided below, then it should follow that claim 17 would likewise be allowable. Accordingly,

applicants respectfully request reconsideration of the requirement as it applies to the relationship between the elected claims and dependent claim 17.

Turning to the inventive entity, applicants note that inventive entity of the present divisional application is the same as the original inventive entity of the parent application and that therefore, the Official Filing Receipt reflects the current correct inventive entity. If cancellation of certain claims requires amendment of the inventive entity, the appropriate steps will be taken.

In the rejections set forth in the Official Action, the Examiner has rejected claim 11 under the second paragraph of 35 U.S.C. §112 for containing the term "phenolic skeleton" and has referred to examples on page 27 as defining this term. The Examiner has also rejected all of the claims under the second paragraph of 35 U.S.C. §112 with respect to the term "thermosetting compound" and for allegedly being unclear with respect to the components in the fine particles. While applicants do not necessarily agree with the Examiner's rejections, claim 3 has been amended to revise the order of components to render more clear the composition of the fine particles and to include the subject matter of claim 11 with claim 11 being accordingly canceled without prejudice or disclaimer. In addition, claim 3 has been amended to include the exemplary materials disclosed on page 27 of the specification referred to by the Examiner. The amendments to the claims are consistent with the Examiner's references to explanatory disclosure in the specification and hence the amendments to the claims should fully meet each of the §112 rejections set forth in the Action. Similar revisions have been made to

independent claim 19 and therefore this claim is also believed to fully comply with the provisions of §112.

As noted above, the prior art rejection does not relate to all of the claims under consideration, but only claims 3, 11 and 14. The prior art applied against these claims, namely Cheng et al., relates to a lithographic printing plate for use on a printing press, which is said to require minimal or no additional processing after exposure to actinic radiation. The plate comprises a printing plate substrate, a polymeric resist layer capable of imagewise photodegradation or photohardening, and a plurality of microencapsulated developers capable of blanket-wise promoting the washing out of either exposed or unexposed areas of the polymeric resist. The microencapsulated developers may be integrated into the polymeric resist layer, or may form a separate layer deposited atop the polymeric resist layer, or may be coated onto a separate sheet support capable of being brought into face-to-face contact with conventional printing plates.

Cheng et al. does not disclose or suggest the presently claimed invention and is actually totally unrelated thereto. The claims of record define a lithographic printing plate precursor comprising an image-forming layer that specifically includes, *inter alia*, fine particles containing a thermosetting compound which is at least a resin selected from a resin having a phenolic skeleton, a melamine resin and a urea resin and wherein the resin having a phenolic skeleton is obtained by resinifying phenol or cresol with aldehydes, hydroxystyrene resins, N-(p-hydroxyphenyl)-methacrylamide or N-(p-hydroxyphenyl)methacrylate.

The disclosed particles of Cheng et al. do not meet the defined particles. Indeed, it can be understood from the present application and particularly certain of the original claims, such as claims 1 and 2, that microcapsules and fine particles are different materials. Furthermore, the microcapsules of Cheng et al. function in an entirely different way. That is, the microcapsules release a developer upon receiving pressure on a press machine so that the developability of the non-exposed area is increased. Such function is totally different from image formation which is attained by the thermosetting of the defined fine particles of the presently claimed invention. Therefore, with a proper understanding of the present invention and in light of the claims now of record, applicants respectfully submit that the claimed invention is patentable in all respects and accordingly request reconsideration and allowance of the claimed subject matter.

Should the Examiner have any questions concerning the subject application, the Examiner is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

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